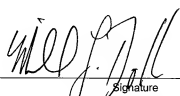| PRE-APPEAL BRIEF REQUEST FOR REVIEW	Docket Number (Optional) 014801-001300US	

I hereby certify that this correspondence is being filed via EFS-Web or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on ___May 12, 2008_____ Signature / Stephanie Klepp / Typed or printed name ___Stephanie Klepp_____	Application Number 09/516,949	Filed March 1, 2000
	First Named Inventor Roger H. Kuite	
	Art Unit 3693	Examiner Stefanos Karmis

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
      Note: No more than five (5) pages may be provided.

I am the

☐   applicant/inventor.

☐   assignee of record of the entire interest.
    See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
    (Form PTO/SB/96)

☒   attorney or agent of record.
    Registration number ___55,127_____.

☐   attorney or agent acting under 37 CFR 1.34.

    Registration number if acting under 37 CFR 1.34 _____

_____
Signature

Michael L. Drapkin
Typed or printed name

303.571.4000
Telephone number

May 12, 2008
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☒   *Total of __1__ forms are submitted.

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PATENT
Attorney Docket No.: 014801-001300US
Client Ref. No.: PD494

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	Confirmation No. 2970
Roger H. Kuite et al.	Examiner: Stefanos Karmis
Application No.: 09/516,949	Technology Center/Art Unit: 3693
Filed: March 1, 2000	ARGUMENTS FOR REASONS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW
For: SYSTEM AND METHOD FOR ELECTRONIC DISTRIBUTION OF BENEFITS	
Customer No.: 20350	

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

        These arguments are forwarded in support of the Pre-Appeal Brief Request for Review, which is submitted herewith, along with a Notice of Appeal. Applicants respectfully request review of the Final Office Action ("Final Office Action") dated January 10, 2008, in view of the Advisory Action ("Advisory Action") dated April 14, 2008.

The Final Office Action maintained the rejection of claims 1-24 under 35 U.S.C. §103(a) as being unpatentable over the cited portions of McDonald, U.S. Patent No. 6,648,222 ("McDonald"), in view of the cited portions of Slater, U.S. Patent No. 6,615,190 ("Slater"). Claims 1-24 are present for examination, and claims 1, 16, and 21 are the independent claims.

As the following discussion will illustrate, neither the Slater or McDonald references teach or suggest:

1) the **transfer** of **monetary benefits value** from a **benefits database** to a **smart card**, *or*

2) the subsequent **writing** of that **transferred value** and **benefit type** to the **smart card**,

as generally recited in claim 1. Claims 16 and 21 contain related limitations. Because the cited references cannot be relied upon to teach or suggest the limitations of independent claims 1, 16, or 21, Applicants believe all claims now pending are allowable.

Transfer to the Smart Card/Writing to the Smart Card

Independent claim 1, for example, recites "an express vending machine … accepting a transfer of at least a portion of the benefits monetary value stored at the benefits storage device to the at least one smart card." The express vending machine of claim 1 includes "a read/write mechanism for … writing the benefits monetary value … to the at least one smart card." Thus, the central computer of claim 1 includes a benefits storage device for storing a benefits monetary value for a patron, and at least a portion of that value is transferred to and written on the smart card. Claim 1 will be used for purposes of example, but note the similarities between claim 1 and the other independent claims.

The Advisory Action appears to concede that McDonald fails to include these limitations, noting that that there is "no value explicitly stored on the card" (Advisory Action, p. 2). In McDonald, the monetary value in not written to or otherwise downloaded to the card. To the contrary, the "value data associated with the card is not carried on the card, but is instead accessed … from a remote database." (McDonald, col. 13, ll. 55-57). The system control center, through associated databases, accesses balance information and responds to requests to use the card (*Id.*, col. 4, ll. 13-25; col. 9, ll. 10-22; FIGS. 1 and 9). Thus, in McDonald, it is clear that

the value associated with a card is stored off the card, instead of being transferred to a card or written thereon.

       The Advisory Action suggests that Slater cures the deficiencies of McDonald, but a closer examination of Slater indicates otherwise. Instead, Slater describes a centralized system 100 including a balance database module "for storing information about the account balance." (Slater, col. 4, ll. 59-60). The system 100 of Slater includes a cardholder I/O module "enabling a cardholder access to a stored value *account*." (*emphasis added, Id.*, col. 6, ll. 1-15). Again, as with McDonald, it appears clear that the value associated with a card is stored and accessed off the card, instead of being transferred to a card or written thereon.

       The Advisory Action states that "the card attaches to I/O module for adding information and funds and also connecting the card with I/O module to retrieve account balances" (Advisory Action, p. 2, *citing* Slater, col. 5, ll. 38-46). But the card in Slater does not physically 'attach' to the I/O module. Although the interpretation being applied by the Office is unclear, the I/O modules are not operable to transfer or write value to the physical smart card itself. The I/O modules may fairly be said to allow funds to be added to a "stored value card *account*," but this falls far short of the transfer and writing limitations of claim 1.

       The I/O modules are at the central system 100, and they do not appear able to change or write a monetary value *on the smart card* (Slater, col. 4, ll. 40-59; Figure 2). For example, while Slater's Issuer I/O module 140 may "add funds," this addition of funds is to a "stored value card account," not to the "stored value card." This falls far short of teaching the transfer of monetary benefits value from a benefits database to a smart card, *or* subsequently writing that transferred value and benefit type to the smart card. Slater plainly provides that a:

       stored value card has *an account* <u>associated</u> with *the card*. A <u>sponsor</u> funds <u>**an account**</u>, and may access other information associated with *the account*, such as the balance of the account and the transactions that have occurred in connection with *the account*. A cardholder may <u>withdraw funds</u> from *the account*, and may <u>access</u> other information associated with *the account*, including the balance in *the account* and various transactions that have occurred with *the account* (*emphasis added*, Slater, col. 2, ll. 41-49).

Thus, in Slater, while there is an account associated with a card, there is no teaching that value be transferred to the card itself, or written to the card.

It is also worth noting how in claim 1 the particular benefit type is written to the card, in addition to the benefits monetary value. This aspect of novelty is not taught in the references, and further distinguishes the claims from the cited art. Claim 1 provides for the selection of a "benefit type from a plurality of benefit types" at the "vending machine," and then sets forth a "write mechanism" for "writing … the benefit type to the … smart card."

Selected limitations from claims 16 and 21 are similar to those set forth above. Claim 16 recites that the central computer downloads "at least a portion of the increased monetary benefit value to the smart card," and then "configur[es] the smart card for a particular benefit type from a plurality of benefit types." Claim 21 sets forth a transfer of "at least part of the monetary benefit value for the patron from the benefits data base to a smart card." In light of the above, the specified limitations in claims 1, 16, and 21 are absent from the cited references.

Applicants respectfully submit that the specified limitations in independent claims 1, 16, and 21 are allowable for at least the foregoing reasons. Claims 2-15 17-20, and 22-24 each depend from these independent claims, and are believed allowable for at least the same reasons as given above. Applicants, therefore, respectfully request that the §103(a) rejections to these claims be withdrawn.

Combination of *McDonald* and *Slater*

In addition, Applicants assert that the references should not be combined for purposes of an obviousness analysis, as their teachings are in direct conflict. A persistent theme of the Slater reference is that a "cardholder can withdraw funds from the account, but cannot deposit additional funds in the account." (Abstract; *see also* Summary: "cardholder is prohibited from adding funds to the account," col. 1, ll. 46-57; Claim 1 "cardholder is unable to fund the account").
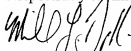
However, McDonald is very different, teaching a system wherein the cardholder who funds the system, and the Description is focused on teaching the ways in which the cardholder funds the account associated with a card (McDonald, col. 8 ll. 24-60; col.14, ll. 11-51). The customer-funded approach set forth in McDonald is in conflict with the sponsor-funded approach of Slater, where customer funding is specifically prohibited.

Because of this conflict, there is insufficient suggestion to combine the references. *See* MPEP § 2143.01. The combination of McDonald and Slater is relied upon to reject claims 1-24. Applicants, therefore, respectfully request that the §103(a) rejections to these claims be withdrawn because the references are not properly combined.

Conclusion

For at least these reasons, it is respectfully submitted that independent claims 1, 16, and 21 are allowable. Claims 2-15, 17-20, and 22-24 each depend from the independent claims, and these claims are believed to be allowable for at least the same reasons. Consequently, Applicants believe all pending claims are allowable over their cited references.

Respectfully submitted,

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